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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,152	02/21/2008	Sung-Nack Lee	0662-0199PUS1	6578
2292 7590 12/31/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
TATE, CHRISTOPHER ROBIN				
ART UNIT		PAPER NUMBER		
1655				
NOTIFICATION DATE		DELIVERY MODE		
12/31/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/562,152

Applicant(s)

LEE, SUNG-NACK

Examiner

Christopher R. Tate

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)
Paper No(s)/Mail Date 1205
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claims 1-5 are presented for examination on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are numerous instances throughout the claims in which misspelled and/or unclear terms are recited including the following:

- In claim 1, the plant genus "houttynia" is misspelled. The correct spelling is --*Houttuynia*--. In addition (for clarity and consistency), please note that the proper manner to recite a botanical plant is to capitalize the first letter of the genus name as well as to italicize the genus and species names - i.e., *Houttuynia cordata*--.

- There is no compound actually known as "licorice acid", *per se* (recited in claims 1 and 4). If the limitation "licorice acid" is meant to define a type of licorice acid, the term --a-- should precede "licorice acid" in claim 1, and the term --the-- should precede "licorice acid" in claim 4.

- In claim 2 (which depends from claim 1), the phrase "saururus extract" is recited. However, there is insufficient antecedent basis for this limitation in claim 2. That is, claim 1 is drawn to a multi-ingredient composition which comprises *Houttuynia cordata* extract as an

element therein, whereas claim 2 omits this required herbal element and replaces it with "saururus extract". Although it is noted by the examiner that the instant specification teaches that *Saururus chinensis* is the botanical name of *Houttuynia cordata* (see, e.g., page 3, paragraph [24], of the instant specification), this statement is factually incorrect as these two plants are well known in the art to constitute two distinct botanical species (see, e.g., various art references cited within the attached Notice of References). Accordingly, it is completely unclear as to which of these botanical plant extracts is actually contained within the instantly disclosed composition. Clarification is requested (Applicants should also amend the specification accordingly so as to clarify this ambiguous teaching therein). Please note, with respect to the art rejection below, this herbal element within the claimed composition (including claim 2 - since it depends from claim 1) has been interpreted and examined on the merits insofar as it reads upon a *Houttuynia cordata* extract.

- Also in claim 2, the phrase "an adequate quantity of distilled water or purified water" (last two lines) because this makes it confusing and unclear as to the amount of the other ingredients defined therein - e.g., is the about 20-80 weight parts of ethanol (as recited in claim 2) the amount of ethanol therein prior to adding "an adequate quantity of distilled water or purified water" or after (if it's prior to the addition of the water, then the defined amounts of each of these other ingredients becomes unclear and relative with respect to the amount of water being added thereto)?

- In claim 3, the terms "ethyleneglycol", "propyleneglycol", and "butyleneglycol" are recited, each of which is confusing and unclear - i.e., there should be a space between the beginning of these terms and the word "glycol" therein (e.g., --propylene glycol--).

- In claim 4, the phrase "elected from the group consisting" is recited which is unclear because it is not proper Markush terminology, and also because the term --of-- should be recited after the word "consisting". The correct overall terminology should be --selected from the group consisting of--.

- Claims 3 and 5 recite "selected from the group consisting" but also do not recite the term --of-- thereafter. For grammatical correctness and clarity, the term --of-- should be inserted after the word "consisting" within this phrase.

- Based upon a search by the Examiner of perfumes/fragrances within deodorant compositions, it would appear that several of the recited perfume essences within claim 5 are misspelled or unclear as to their meaning including the terms "anisol" (apparently should be --aniso--), "cumarine" (apparently should be --coumarin--), and "1-carbon" (it is completely unclear as to the meaning of this term with respect to defining a perfume essence).

- Also in claim 5, the metes and bounds of the final ambiguous phrase "and or other essence oil" are not clearly nor adequately delineated (e.g., which and/or how many other essence oils are envisioned/defined by this phrase?).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd et al. (US 6,344,218), in view of Li et al. (US 6,174,521), Choi et al. (IDS reference: KR 2003-0043302 - English Abstract), Aoki et al. (JP 2000079158 - JPAB Abstract), Sakiguchi (JP 2002080335 - DWPI English Abstract), and Betts (US 5,525,331).

A composition useful against sweat osmidrosis comprising ethanol, a polyol (such as ethylene glycol, propylene glycol, and/or glycerin), triclosan, allantoin, a licorice acid (such as glycyrrhetic acid), camphor, *Houttuynia cordata* extract, green tea extract, aloe extract, water, and perfume essence is apparently claimed.

Dodd et al. beneficially teach topical deodorant compositions which comprise, or may comprise, ethanol, a polyol (such as ethylene glycol, propylene glycol, and/or glycerin), camphor (in the form of camphor gum), water, and one or more fragrances (perfume essences) such as eugenol and/or geraniol - as active and/or desired agents therein - each apparently within the instantly claimed amount ranges (as best understood) - see entire document. Dodd et al. do not expressly teach the inclusion of the other instantly claimed ingredients therein.

Li et al. beneficially teach topical deodorant compositions which comprise, or may comprise, soothing agents such as aloe vera (which is well known to constitute the extracted gel obtained from this plant) and allantoin, as well as triclosan, glycols (such as glycerin), water, and fragrances (perfume essences) such as bergamot oil, camphor, citrus oils, and/or other essence oils - as active and/or desired agents therein (see entire document).

Choi et al. beneficially teach a topical deodorant composition which comprises *Houttuynia cordata* extract and licorice extract (please note that the licorice extract would intrinsically contain one or more naturally-occurring licorice acids) - as bioactive herbal ingredients therein, each apparently within the instantly claimed amount ranges (as best understood) - see English Abstract.

Aoki et al. beneficially teach a topical deodorant composition (e.g., for deodorizing body odor) comprising green tea extract as a bioactive herbal ingredient therein - see English Abstract.

Sakiguchi beneficially teaches a topical deodorant composition comprising salicylic acid, as well as camphor, menthol, and triclosan - as active and/or desired agents therein (see English Abstract).

Betts beneficially teaches a topical deodorant composition comprising glycyrrhetic acid as an anti-inflammatory agent (apparently within the instantly claimed amount range, as best understood), as well as triclosan, one or more polyols, allantoin, and aromatic phenols (perfume essences) such as eugenol - as active and/or desired agents therein (see entire document).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to further include other well known active and/or desired ingredients (such as those instantly claimed) within topical deodorant composition such as those disclosed by Dodd et al. based upon the beneficial teachings provided by the secondary references cited above with respect to the conventional use of such active/desirable agents therein, as discussed above. In addition, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit since each is well

known in the art for the same purpose (i.e., each is well known to be useful as active/desirable ingredients within deodorant compositions including topical deodorant compositions) and for the following reasons. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. In re Kerkhoven, 626 F.2d 846, 850, 205 U.S.P.Q. 1069 (CCPA 1980), In re Sussman, 1943 C.D. 518; In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). The result-effective adjustment of particular conventional working conditions (e.g., determining suitable amounts of such ingredients therein) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan having the cited references before him/her as a guide.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher R. Tate/
Primary Examiner, Art Unit 1655